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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,469	10/12/2000	Anne Marie Schmidt	0575/55424-A-PCT-US/JPW/J	7726

7590

09/15/2003

John P. White
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

YAEN, CHRISTOPHER H

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 09/15/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/689,469

Applicant(s)

SCHMIDT ET AL.

Examiner

Christopher H Yaen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-60 and 76-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-60 and 76-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>13</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 11/12/2002 (paper no. 12) is acknowledged and entered into the records. Accordingly, claims 42-56, 61-75, and 79-81 are canceled without prejudice or disclaimer.

2. Therefore, claims 57-60 and 76-78 are pending and examined on the merits.

Information Disclosure Statement

3. The Information Disclosure Statement filed 11/12/2002 (paper no. 13) is acknowledged and considered. A signed copy of the IDS is attached hereto.

Claim Rejections Maintained - 35 USC § 103

4. The rejection of claims 57-60 and 76-78 under 35 USC 103 (a) as being obvious over Hori *et al* in view of Miki S *et al* is maintained for the reasons of record. Applicant argues that the combination of the references do not anticipate the instantly claimed invention because the limitations recited are not present in the cited references. Applicant also argues that examiner uses hindsight information presented by the applicant to piece together references to beat patentability. Applicant's arguments have been carefully considered but are not found persuasive. In order for a reference to stand as a legitimate 103(a) prior art reference, it does not need to teach each and every limitation of the art as long as there is sufficient motivation and reasonable expectation of success. In this case, Hori *et al* teach a method of comprising the steps of coating a solid support with amphoterin, admixing sRAGE in the presence of cells expressing RAGE and measuring the binding of the said cells to the solid support coated with amphoterin. Miki S *et al* teach that renal cell carcinomas (RCC) express

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RAGE. One of ordinary skill in the art would have found a reasonable expectation of success in using tumor cells instead of neuronal cells in the method of screening for agents (i.e. sRAGE) because Miki S *et al* taught that RAGE is expressed on RCCs and one of ordinary skill in the art would expect that any cell as long as the cells express RAGE could be substituted into the method of Hori *et al* and would have had the same result of screening as accomplished by Hori *et al*. Although Hori *et al* do not implicitly recite the limitations of the instantly claimed invention, the method steps taught are identical. Furthermore, it was well known and established at the time the invention was made that RAGE was expressed on RCCs, as evidenced by Miki S *et al*, and that amphotericin (a natural ligand for RAGE) was involved in the invasiveness of neoplastic lesions. One of ordinary skill would have found motivation to combine the references because it was known that RAGE was expressed on RCCs, amphotericin had been implicated in tumor cell invasiveness, and that RAGE was determined to be the receptor for amphotericin. Taken together, one of ordinary skill could have easily substituted the neuronal cells (used by Hori *et al*) with tumor cells because it was well known and established in the art that both RAGE and amphotericin were associated with tumor cells.

All other rejections are withdrawn in view of the arguments and or amendments thereto as set forth in paper no. 12.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 703-305-3586. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Christopher Yaen
Art Unit 1642
September 10, 2003


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600